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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,186	09/30/2003	Edward D. Riley	16432-0042	5675
24267	7590	10/25/2005	EXAMINER	
CESARI AND MCKENNA, LLP 88 BLACK FALCON AVENUE BOSTON, MA 02210			FIDEI, DAVID	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 10/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/675,186	<b>Applicant(s)</b> RILEY, EDWARD D.	
	<b>Examiner</b> David T. Fidei	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) 14-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/4/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Construction*

1. In analyzing applicant's invention as set out in the pending claims, the examiner sets forth the following to aid in understanding the application of the prior art herein. Claims are to be given their broadest reasonable during prosecution, see *In re Priest*, 582 F.2d 33, 37 199 USPQ 11, 15 (CCPA 1978), and limitations from the specification will not be read into the claims, see, e.g. *In re Prater*, 415 F.2d 1393, 1404-1405, 162 USPQ 541, 550-51 (CCPA 1969). Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997), see MPEP 2106.

Claim 1 recites a first web connecting and supporting the tubes in parallel space-apart relation so that fluid can circulate around and between the first tubes that is considered a non-limiting functional limitation. In order to further limit the claim there must be some distinction based upon the intended use recited. "However, in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art, see M.P.E.P. § 2111.02 THE INTENDED USE MAY FURTHER LIMIT THE CLAIM IF IT DOES MORE THAN MERELY STATE PURPOSE OR INTENDED USE. The examiner can see no structural differences between the claimed invention and the prior art based upon a first web connecting and supporting the first tubes "so that a fluid can circulate" around and between the tubes.

If applicant wishes to distinguish their invention over the prior art based upon this intended use, they should specifically recite those structural characteristics permitting this feature so that the Examiner can determine whether any differences are novel or unobvious.

As to claim 11, printed matter is recited on the top of the holder module in the form of graphics. In order distinguish this subject matter over the prior art it is necessary that there be some functional relationship between the graphics and the module. Although factually distinct, the *In re Ngai*, 70 USPQ2d 1862 (Fed. Cir. 2004) and *In re Gulack*, 217 USPQ 410 (Fed. Cir. 1983), held the same basic premise of "where the printed matter is not functionally related to the

substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. In the present instance any representation of printed matter on top of a module equivalent to that module, in as much as is claimed, is held sufficient by the Examiner to meet the claimed limitations, i.e., it is not necessary that the printed matter of claim 13 expressly indicate the instruments within the first passages to anticipate the claim.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 6-10, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Roster (Patent no. 5,967,318). A holder assembly as claimed is disclosed comprising a holder module 3 including a plurality of first tubes 6 defining first passages having open upper and lower ends, see figure 1. A first web (any of 5a, 5b, 8 or 10) connects and supports the tubes in parallel space-apart relation so that fluid can circulate around and between the first tubes. In as much as is claimed fluid could circulate around and between the tubes if immersed in such a fluid. Also instrument supports are located at the lower ends of the tubes for supporting instruments placed in the first passages while allowing a fluid to circulate through the first passages that can be considered any of the structures 4, 8, 9 and 11.

As to claim 2, the passages are flared at 12.

As to claim 6, the cover 2 has a seating surface as shown in figure 1 and 5.

As to claim 7, the first web 5b of figure 2 constitutes a top wall of the base and a peripheral web extending down from the first web around the plurality of tubes forms a peripheral web as well as the side wall of the base 3 defining a seating surface for the cover 3 in as much as is claimed.

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As to claim 8, the base 3 in the alternate embodiment of figure 6 includes a plurality of "keys" 18 which extend below the seating surface of the cover, note figure 5, and are arranged (opposite one another) to key into a surface underlying and supporting the base.

As to claim 9 connecting webs are defined at 5b, 5a bottoms members 8 and 10 in the embodiment of figure 5.

As to claim 10, the first web 5b comprises a top web that extends between upper ends of the first tubes and constitutes a top wall of the base.

As to claim 12, members 9, 10a and 4 are considered bridges in as much as is claimed.

As to claim 13, the instrument support is a base bottom wall 4 support by at least one first web 8 or 10 so that the bottom wall is space below the lower ends of the first passages.

4. Claims 1, 3, 4, 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Denton et al (Patent no. 5,850,917). A holder assembly as claimed is disclosed comprising a holder module 12 including a plurality of first tubes defining first passages having open upper and lower ends through the foam material, see figure 6. A first web 34 connects and supports the tubes in parallel space-apart relation in as much as is claimed. Also instrument supports 16 (figure 6) are located at the lower ends of the tubes for supporting instruments placed in the first passages. A cover 36 is also disclosed.

As to claims 3 and 4, a plurality of second tubes are disclosed in collinear relationship 28 where the first passages are shorter than second passages, see figure 6.

As to claim 11, graphics 32 are disclosed on the top web.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the limitation "the instrument support means" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is also unclear if claim 13 intends to invoke 35 U.S.C. 112, sixth paragraph.

### ***Claim Objections***

6. Claim 13 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 13 recites "instrument support means" which could be construed as a means plus function recitation provide by 35 U.S.C. 112, sixth paragraph. A means recitation recited as provided by this statute is not limited to the specific structure previously recited but encompasses equivalents thereof, and is therefore broader than that claim from which is depends.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denton et al (Patent no. 5,850,917). The difference between claim 5 and Denton et al resides in the dimensions of the upper and lower ends of the second passages. It would have been an obvious matter of design choice to dimension the ends of any parameter disired, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ

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237 (CCPA 1955). Also, it has been held that where the only difference between the prior art device and the claimed device was a recitation of relative dimensions, the claimed device was not patentably distinct from the prior art device, *Gardner v. TED Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. Denied, 469 U.S. 830, 2325 USPQ 232 (1984), see M.P.E.P. 2144.04 (IV).

***Allowable Subject Matter***

9. Claims 14-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**REPLY BY APPLICANT OR PATENT OWNER TO THIS OFFICE ACTION**

10. “In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to every ground of objection and rejection in this Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. The applicant’s or patent owner’s reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. The reply must be reduced to writing (emphasis added)”, see 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.

Pointing out specific distinctions means clearly indicating in the written response what features/elements or distinctions have been added to the claim/claims, where support is found in the specification for such recitations and how these features are not shown, taught, obvious or inherent in the prior art.

If no amendments are made to claims as applicant or patent owner believes the claims are patentable without further modification, the reply must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office Action in the same vain as given above, 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.

The examiner also points out, due to the change in practice as affecting final rejections, older decisions on questions of prematureness of final rejection or admission of subsequent amendments do not necessarily reflect present practice. "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)" (emphasis mine), see MPEP 706.07(a).


#### **Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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David T. Fider  
Primary Examiner  
Art Unit 3728

dtf  
October 24, 2005